(27)

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1942.

No. 657

EDWARD ARMSTRONG BELLOW AND McDONALD PRODUCTS CORPORATION,

Petitioners,

vs.

PARK SHERMAN CO., INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT

and

BRIEF IN SUPPORT THEREOF.

ALBERT G. McCALEB,
J. DAVID DICKINSON,
Counsel for Petitioners.

THE BUNTHORP-WARREN PRINTING COMPANY, 310 WEST JACKSON, CHICAGO

INDEX.

Petition for Writ of Certiorari.

Brief in Support of the Petition for Writ of Certiorari.

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1942.

No. .....

EDWARD ARMSTRONG BELLOW AND McDONALD PRODUCTS CORPORATION,

Petitioners,

vs.

PARK SHERMAN CO., INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI.

To The Honorable, The Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners, Edward Armstrong Bellow, a subject of the King of England, and McDonald Products Corporation, a corporation of the State of New York, respectfully pray for a writ of certiorari to review a decree of the United States Circuit Court of Appeals for the Seventh Circuit. Such decree (Rec. p. 238) was entered pursuant to an opinion (Rec. p. 235) dated November 6, 1942, in a case entitled *Edward Armstrong Bellow and McDonald Products Corporation, Plaintiffs-Appellants,* v. *Park Sherman Co., Inc., Defendant-Appellee.* Such opinion is reported at 55 U. S. P. Q. 310. A petition for rehearing was denied December 18, 1942 (Rec. p. 239). The mandate of the Circuit Court of Appeals has been stayed to accommodate the instant petition (Rec. p. 239).

Summary Statement of the Matter Involved.

The circumstance that a patentee dealt with no new principles of physics has been recognized as a patent invalidating defense.

The defense thus recognized is strange to American patent law and repugnant to R. S. 4886 (U. S. C. Title 35, Sec. 31).

Petitioners' counsel estimate that such defense, if a defense, will invalidate fully three-fourths of the United States patents in existence.

New principles of physics are only rarely discovered; and but very few patentees have dealt with (or discovered) them.

Your petitioners' Bellow Patent No. 2,219,974 (Rec. p. 169) is for a manufacture, in the nature of an ash tray unit, now commonly known as the bean bag tray. The validity of such patent was the one and only issue before the Circuit Court of Appeals. In deciding that single issue adversely to your petitioners, the Court of Appeals said:

> "Bellow dealt with no new principles of physics." (Opinion—Rec. p. 236.)

On appealing to the Circuit Court of Appeals from the decree of the trial court, your petitioners had presented an assignment of error as follows:

> "5. The court erred in attaching significance to the fact that the patentee Bellow was not 'working with new principles of physics.' " (Assignment of Errors—Rec. p. 163.)

Such fifth assignment of error had been presented because the trial court, in its opinion (Rec. p. 155, line 1) and in its findings (Rec. p. 159, line 29) had set forth, as a reason for holding your petitioners' patent invalid, the circumstance that the patentee Bellow (like the patentees

who had produced the prior art devices presented in the case) was not

"working with new principles of physics".

Thus, it appears that the above quoted statement from the opinion of the Circuit Court of Appeals is not an *obiter dictum*. It disposes of the issue presented by the above quoted fifth assignment of error. Moreover, it constitutes a dangerous precedent because purporting to state a new patent invalidating defense.

Jurisdiction.

1. The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code, as amended by the Act of February 13, 1925 (28 U. S. C., Sec. 347).

2. The matter to be reviewed arises in a suit under the Patent Laws of the United States, Judicial Code, Sec. 24(7) (28 U. S. C., Secs. 41-7).

3. The questions presented are to be determined under said patent laws.

The Questions Presented.

The questions presented are:

(1) Shall patents (for the inventions and discoveries contemplated by R. S. 4886; U. S. C., Tile 35, Sec. 31) be held invalid because their patentees have dealt with no new principles of physics?

(2) Was the Bellow patent No. 2,219,974 (in respect to which the Circuit Court of Appeals said: "Bellow dealt with no new principles of physics") properly held invalid?

Reasons for Granting the Writ.

Your Honors' discretion should be exercised in favor of granting a writ of certiorari because

(1) The Circuit Court of Appeals for the Seventh Circuit has recognized a patent invalidating defense never previously recognized by the Supreme Court or any other Circuit Court of Appeals.

(2) The defense thus recognized is repugnant to R. S. 4886 (U. S. C., Title 35, Sec. 31).

(3) The circumstance which constitutes such newly recognized defense (*i. e.*, the circumstance that no new principles of physics were dealt with when a patentee happily integrated several individually old elements into an unanticipated problem-solving gadget) is one which will continue to be encountered with great frequency in patent litigation; wherefore it is much to be desired that such question be considered and settled by Your Honors at this time.

For the aforesaid reasons, it is urged that this petition for writ of certiorari to the United States Circuit Court of Appeals for the Seventh Circuit be granted.

Respectfully submitted,

ALBERT G. MCCALEB,
J. DAVID DICKINSON,
Counsel for Petitioners.

Chicago, Illinois,
January 12, 1943.

BRIEF IN SUPPORT OF THE PETITION FOR WRIT OF CERTIORARI.

Opinions of the Courts Below.

The opinion of the trial court appears at 52 U. S. P. Q. 364 and at Rec. p. 152. The opinion of the Circuit Court of Appeals appears at 55 U. S. P. Q. 310 and at Rec. p. 235. December 18, 1942 (date of denial of petition for rehearing) is the significant date of the decree to be reviewed.

Jurisdiction.

See petition (page 3, *ante*).

Matter Involved.

The matters for determination by this court are

(1) Shall patents be held invalid because their patentees have dealt with no new principles of physics?

(2) Was the Circuit Court of Appeals, influenced as it was by its finding that the patentee Bellow dealt with no new principles of physics, justified in holding the Bellow patent invalid?

Your petitioners admit (and never have denied) the fact to be that the patentee Bellow dealt with no new principles of physics.

Federal Statute Involved.

R. S. 4886. (U. S. C., Title 35, Sec. 31.) Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented

or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

Specification of Errors Intended To Be Urged.

The errors which petitioners will urge, if the petition for writ of certiorari is granted, are these:

(1) That the Circuit Court of Appeals erred in attaching significance to the fact that the patentee Bellow was not working with new principles of physics. (Such fact being immaterial in view of R. S. 4886.)

(2) That the Circuit Court of Appeals, in arriving at its conclusion that the Bellow patent is invalid, erred in relying upon the fact that the patentee dealt with no new principles of physics.

(3) That the Circuit Court of Appeals erred in failing to hold the Bellow patent valid for the reason, *inter alia*, that the patentee so combined three elements as to meet a long felt public need with a simple problem solving gadget in which one of the elements bears an entirely new performance improving relationship to each of the other two elements.

ARGUMENT.

The Matter Presented Is Serious and of Great Public Importance.

The instant case is believed to be the very first, in the history of American patent law administration, in which the fact that a patentee dealt with no new principles of physics has been judicially set forth as a reason for holding his patent invalid.

Very few patentees have dealt with new principles of physics in evolving their contributions to human progress. The vast majority of inventors deal only with those principles of physics which are old and well known. These are truisms. New principles of physics are only very rarely discovered.

Consequently, most United States patents now in existence, no matter how meritorious the inventions they purport to cover, are invalid if patents properly are to be held invalid, as the opinion of the court below indicates, because their patentees have dealt with no new principles of physics.

It is estimated by your petitioners (and the estimate is believed to be quite conservative) that no less than three-fourths of the United States patents now in existence cover improvements which were evolved without anyone dealing with new principles of physics.

The Patent Invalidating Defense Recognized by the Circuit Court of Appeals Is Repugnant to R. S. 4886 (U. S. C. Title 35, Sec. 31).

R. S. 4886 is set forth at page 5, *ante*. It is that fundamental section of our patent law which specifies what persons may obtain United States patents. It contains absolutely nothing supporting the proposition that only persons who have dealt with new principles of physics may obtain patents; and it is plainly repugnant to such proposition because providing that

> "*Any person* who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, * * * may * * * obtain a patent therefor."

Surely the patent statutes do not justify the court below in having accorded probative force or significance, on the question of validity, to the circumstance that the patentee Bellow dealt with no new principles of physics. It cannot be doubted that the court below did attach much probative force or significance to such circumstance; because the record shows that the inclusion in that court's opinion of the statement that

> "Bellow dealt with no new principles of physics"

was, in effect, its ruling in respect to your petitioners' afore-mentioned fifth assignment of error reading as follows:

> "5. The court erred in attaching significance to the fact that the patentee Bellow was not 'working with new principles of physics.' " (Assignment of Errors—Rec. p. 163.)

Conclusion.

The American patent system has become an old one. Over two and one-quarter million patents have been granted. Nearly three-quarters of a million of these have not expired. Thousands of patent suits have been decided. Patents have been assailed upon almost every conceivable ground. It is reasonable to assume that the courts of the United States have considered every defense which reasonably can be asserted against the validity of a patent granted under our patent statutes. When what purports to be a new defense questions the validity of a patent granted under those statutes, it should be viewed with suspicion until its soundness has been demonstrated beyond doubt. When it appears that one of the Circuit Courts of Appeals has accepted such a defense without considering its repugnancy to or harmony with the patent statutes, its action is presumably in error, and should, without doubt, be reviewed by Your Honors. This is especially true in the instant case, because the action of the Circuit Court of Appeals not only vitiates your petitioners' patent; it actually challenges the validity of thousands of other patents as well.

The welfare of our patent system requires that the writ prayed for be issued.

Respectfully submitted,

ALBERT G. MCCALEB,
J. DAVID DICKINSON,
Counsel for Petitioners.

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1942.

No. 658657

EDWARD ARMSTRONG BELLOW and McDONALD PRODUCTS CORPORATION,

Petitioners,

vs.

PARK SHERMAN CO., INC.,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

RALPH M. SNYDER,
CARL F. GEPPERT,
Counsel for Respondent.

BARNARD & MILLER, 33 S. Market St., Chicago. FRAnklin 0562

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1942.

No. 658

EDWARD ARMSTRONG BELLOW and McDONALD PRODUCTS CORPORATION,

Petitioners,

vs.

PARK SHERMAN CO., INC.,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

The petition is without merit for the following reasons:

(1) Neither of the two questions presented in the petition is material in view of the undisputed fact that the Trial Court, after full trial in open court, held the Bellow patent in suit and each of its claims invalid for want of invention over what defendant itself had for many years previously been doing, and modified by merely adding an admittedly old flexible bag containing shot to perform the

same function as in the prior art. The Trial Court also found and held that the disclosures in the pertinent prior art negatives and refutes novelty of the patent in suit and establishes want of invention; and that all of the ideas which the patentee applied to his ash tray were applied by the prior art to similar holders. Findings of Fact 8, 9, 10, 13 and 16—R. 159, 160.

The want of invention for these reasons was also clearly indicated in the language of the Trial Court, Judge Barnes, in his decision, R. 152, beginning at the bottom of page 154.

(2) The Court of Appeals unanimously affirmed on the same findings of fact—131 F. (2d) 599, R. 235. The opinion clearly discloses careful consideration of the prior art and the lack of any contribution by the patentee beyond that produced by the ordinary skilled mechanic. R. 235 at middle of page 236.

(3) This case was not decided by either the Trial Court or the Court of Appeals on the ground that the patentee "dealt with no new principles of physics" (as alleged by petitioner). The Findings of Fact and the opinion of the Trial Court and of the Court of Appeals show that the patent was held invalid for want of invention as not beyond the skill of an ordinary mechanic and for lack of novelty over the prior art. Not only does the basis of the decisions clearly appear from the findings and opinions, but the language of the opinion of the Court of Appeals clearly shows that while the phrase "no new principles of physics" was used, it was used incidentally. The opinion, after discussing the prior art, states (R. 236):

> "In view of this antiquity, it follows that, if invention exists, it must arise from the fact that the specific prescribed combination possesses novelty and utility beyond that produced by the skilled mechanic. Bellow dealt with no new principles of physics. *Rather he employed the well known expedient of an adaptable*

container partially filled with weighty material conforming to the surface upon which it is placed. This he attached to the old ash tray. Obviously the ordinary smoker who places his ash tray upon a sofa pillow solves the problem in a manner not far removed from that employed by Bellow." (Emphasis ours.)

The language of the opinion itself refutes counsel's insistence that the court had introduced a new defense in patent suits.

There is no conflict or shadow of conflict between the unanimous decisions of the Trial Court and the Court of Appeals and the decisions of this or any other Court.

No reason has been advanced why this Court should entertain jurisdiction of this case.

It is respectfully submitted that the petition for Writ of Certiorari should be denied.

RALPH M. SNYDER,
CARL F. GEPPERT,
Counsel for Respondent.

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1942.

No. 657

EDWARD ARMSTRONG BELLOW AND McDONALD PRODUCTS CORPORATION,
Petitioners,

vs.

PARK SHERMAN CO., INC.,
Respondent.

REPLY BRIEF FOR PETITIONERS.

ALBERT G. McCALEB,
J. DAVID DICKINSON,
For Petitioners.

THE BUNTHORP-WARREN PRINTING COMPANY, 310 WEST JACKSON, CHICAGO

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1942.

No. 658

EDWARD ARMSTRONG BELLOW AND McDONALD PRODUCTS CORPORATION,

Petitioners,

vs.

PARK SHERMAN CO., INC.,

Respondent.

REPLY BRIEF FOR PETITIONERS.

Respondent's brief does not contain a word in support of the proposition that failure of a patentee to deal with new principles of physics is a circumstance militating against the validity of his patent,—and it does not deny that R. S. 4886 (U. S. C., Title 35, Sec. 31) is repugnant to that proposition.

But respondent's brief (p. 2) suggests that the Circuit Court of Appeals stated only "incidentally" that the patentee Bellow dealt with no new principles of physics.

Whether the statement was made by the court as one of the controlling considerations for its decision, or was made but incidentally or casually, is not to be determined only from the text of the opinion; the history of the case must be considered.

The history of the case is that the trial judge in his dec
sion emphasized (Rec. p. 155, line 1) that Bellow was no
"working with new principles of physics"; that on appe
your petitioners assigned error (Rec. p. 163) on the par
of the trial court in attributing significance to such circum
stance; and that the Circuit Court of Appeals deliberatel
re-emphasized such circumstance in its opinion (Rec. p
236).

Therefore, such statement of the Circuit Court of Ap
peals cannot be dismissed as an incidental remark. It mus
be regarded as setting forth a circumstance which the cour
regarded as irreconcilable with the validity of any patent

Respectfully submitted,

ALBERT G. MCCALEB,
J. DAVID DICKINSON,
For Petitioners